

REMARKS/ARGUMENTS

In response to the Office Action dated November 4, 2003, claims 41 and 42 are amended. Claims 2-10 and 30-43 are now active in this application. No new matter has been added.

The indication that claims 39-41 are allowable, that claims 9, 10 and 37 would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims, and that claim 42 would be allow if rewritten to overcome noted indefiniteness is acknowledged and appreciated.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claim 42 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner notes that “said controller” and “the initial condition” lack proper antecedent support. By this response, claim 42 is amended to depend from claim 41, thereby providing proper antecedent support for the proscribed language. Consequently, withdrawal of this rejection is respectfully solicited.

Claim 41 is amended to add “the” in the phrase “...by one of the image forming portions different from...”

REJECTION OF CLAIMS UNDER 35 U.S.C. § 102 AND § 103

I. Claims 2-5, 30-36, 38 and 43 are rejected under 35 U.S.C. §103(a) as being unpatentable over Umeda (JP# 06-67141) in view of Vincent (USPN 5,866,284).

II. Claims 6-8 are rejected under 35 U.S.C. §103(a) as being unpatentable over Umeda (JP# 06-67141) in view of Vincent (USPN 5,866,284), as applied to claims 2-5, 30-36, 38 and 43, and further in view of Miyasaka et al.

III. The rejections are respectfully traversed.

In imposing a rejection under 35 U.S.C. §103, the Examiner is charged with the initial burden of identifying a source in the applied prior art for claim limitations. *Smiths Industries Medical Systems v. Vital Signs*, 183 F.3d 1347, 51 USPQ2d 1415 (Fed. Cir. 1999). That burden has not been discharged.

With respect to independent claims 30 and 43, Vincent '284 discloses that a reversible image formation mode is automatically switched to a normal image formation mode. However, this disclosure only can be found in the explanation of an image forming apparatus of an embodiment in which, when non-reversible paper is detected when the reversible printing mode was specified, this is informed and the reversible printing mode is automatically switched to the normal printing mode, as a substitute.

Vincent '284 does not disclose that when reversible paper is detected when the normal printing mode was specified, this is informed and the normal printing mode is automatically switched to the reversible printing mode.

While the Examiner asserts on page 3 of the Official Action, "For example, the normal image forming will be designated in advance and if a reversible media is detected, the selector will select the reverse image formation", such assertion is not what is described at column 7, lines 45-65. Only the case that, when the reversible printing mode is set and non-reversible paper is detected, then the reversible printing mode is automatically switched to the normal

printing mode is described. Thus, the Examiner's assertion as to what is disclosed in Vincent '284 is not support by the actual disclosure in the reference.

Thus, the Examiner did not establish a *prima facie* basis to deny patentability to the inventions recited in claims 30 and 43 for want of the requisite factual basis. Therefore, one having ordinary skill in the art would not have found the inventions of claims 30 and 34, as a whole, obvious over Umeda and Vincent '284, considered alone or in combination.

Claim 34 recites:

- a plurality of cassettes which include a first cassette for containing a normal image display medium and a second cassette for containing a reversible image display medium;

- a first image forming portion for forming an image on the normal image display medium provided from the first cassette;

- a second image forming portion for forming an image on the reversible image display medium provided from the second cassette;

- a receiving unit for receiving an instruction of image formation on the normal or reversible image display medium; and

- a designating device for designating, in advance, one of the image forming portions to be selected when the instruction is received by the receiving unit.

Umeda does not disclose a matter or condition upon which the image forming process is switched/selected. Also, none of the applied prior art references teach an image forming apparatus having a plurality of cassettes including a cassette for accommodating reversible image display mediums and a cassette for accommodating normal image display mediums. Furthermore, in the image forming apparatus recited in claim 34, it is possible to form an image by designating a kind of medium to be used for image formation at each of the times of image formation. Umeda does not disclose a designating device for designating, in advance, one of

image forming portions (image forming processes) to be selected in response to the image formation instruction.

Thus, the Examiner did not establish a *prima facie* basis to deny patentability to the invention recited in claim 34 for want of the requisite factual basis also. Therefore, one having ordinary skill in the art would not have found the invention of claim 34, as a whole, obvious over Umeda and Vincent '284, considered alone or in combination.

CONCLUSION

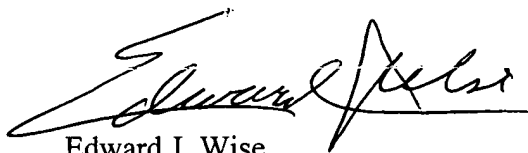
Accordingly, it is urged that the application, as now amended, overcomes the rejection of record and is in condition for allowance. Entry of the amendment and favorable reconsideration of this application, as amended, are respectfully requested. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

09/875,265

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY

A handwritten signature in black ink, appearing to read 'Edward J. Wise', with a stylized flourish at the end.

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